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10/052,365	01/23/2002	Shigeru Miyamoto	723-1250	4052

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EXAMINER

ASHBURN, STEVEN L

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 10/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,365

Applicant(s)

MIYAMOTO ET AL.

Examiner

Steven Ashburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 69-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 69-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Information Disclosure Statement

The examiner's consideration under MPEP 609 of the non-English language references cited on submitted Information Disclosure Statement is limited to the extent described for the cited non-English documents and any corresponding translations therein only so far as the particular portion respectively translated and without reference to a complete invention thereof. It is further noted that the translations are not attested as to their accuracy.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The abstract of the disclosure is objected to because it is not descriptive of the claimed invention. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 74 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims states, " instruction in said memory media control said game program executing processing system to apply a different relationship between the amount of joystick change and the speed of motion in the acceleration and deceleration modes." The claim is indefinite because there is no antecedent

Art Unit: 3714

description of a primary relationship between the amount of joystick change and the speed of motion in the acceleration and deceleration modes.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 69-76, 79 and 81 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 13-29, of U.S. Patent No. 6,244,959 B1 to Miyamoto et al (hereinafter "*Miyamoto '959*"). Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims all the features of the instant claims including:

Art Unit: 3714

- a. Displaying a character and responding to changes in joystick position to control the direction of motion of the controlled character and responding to the amount of change in the joystick angular rotation to control the rate of the character's motion. *See '959, claims 13, 21. (Claim 69)*
- b. Displaying a character running motion if the amount of joystick angular rotation is above a predetermined value. *See Miyamoto '959, claims 14-16, 22-24. (Claim 70)*
- c. Displaying a character in a running motion which is at a higher rate than when the amount of joystick angular rotation is a first predetermined value, if the amount of joystick angular rotation is at a second predetermined value greater than the first predetermined value. *See id. (Claim 71)*
- d. Displaying the character in a walking motion if the amount of joystick angular rotation is below a predetermined value. *See id. (Claim 72)*
- e. Displaying the character in one of an acceleration running mode and a deceleration running mode. *See Miyamoto '959, claims 17, 25. (Claim 73)*
- f. Applying a different relationship between the amount of joystick change and the speed of motion in the acceleration and deceleration modes. *See Miyamoto '959, claims 18, 26. (Claim 74)*
- g. Detecting whether a character is moving on a sloped surface and to modify the character's moving speed as a function of the slope of the surface. *See Miyamoto '959, claims 3-6, 19, 20. (Claim 75)*
- h. Detecting whether the character is moving on an upwardly inclined sloped surface relative to the character's direction of movement. *See id. (Claim 76)*

Art Unit: 3714

- i. Detecting whether a character is being subjected to an environmental condition and to control the character's movement as a function of the detected condition. *See Miyamoto '959, claims 7, 29. (Claim 79)*
- j. Environmental condition is the condition of the terrain on which the character is disposed and the character's movement is controlled as function of the terrain condition. *See id. (Claim 81)*

As listed above U.S. Patent No. 6,244,959 describes all the features of the instant claims. Thus the claimed invention is unpatentable because the features are not patentably distinct.

Claims 77, 82 and 83 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 13-29, of *Miyamoto '959* in view of SONIC THE HEDGEHOG released in 1991 by Sega, Inc (hereinafter "*Sonic*")

Miyamoto '959 claims all the features of the claimed invention except the following:

- a. Displaying the character in a running motion with the upper body tilted forward if the amount of the angular rotation is above a first predetermined value. *(Claim 77)*
- b. Detecting whether the character has been motionless for a predetermined period of time to control the motion of the character to be indicative of inactivity. *(Claim 82)*
- c. Displaying the character in a sleeping state. *(Claim 83)*

Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan in view of *Sonic*.

Sonic describes an analogous "platform-type" video game wherein software executed by a game console allows a player to control a game character based on the operational amount of a joystick. The character's body is depicted in various positions depending on the user's inputs. By changing the operation amount of the joystick input, the game character's speed is increased. Accordingly, the game

Art Unit: 3714

character's body is animated in various states to depict different running speeds with the upper body tilted forward if the amount of the angular rotation is above a first predetermined value. (*Claim 77*).

Additionally, if the player does not input a command for a predetermined period such that the game character remains motionless, the game character will be display behaviors indicating boredom such as yawning, tapping his foot and checking his watch. (*Claims 82, 83*). Sleeping is in equivalent means of indicating such inactivity in a video game. (*Claim 83*).

In view of *Sonic*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Miyamoto '959* to add the features of displaying the character in a running motion with the upper body tilted forward if the amount of the angular rotation is above a first predetermined value and detecting whether the character has been motionless for a predetermined period of time to control the motion of the character to be indicative of inactivity by displaying the character in a sleeping state. The modification would increase the attraction of players by endowing the game character with realistic movement characteristics and personality traits to enhance the player's interaction with the game thereby increase the developer's revenues by attracting a greater number of consumers.

Claims 78 and 80 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 13-29, of *Miyamoto '959* in view of *Sonic*, as applied to claims 77, 82 and 83 above, in further view of Shimojima et al., U.S. Patent 6,022,272 (Feb 8, 2000) (hereinafter "*Shimojima*").

The video game system suggested by the combination of *Miyamoto '959* with *Sonic* describes all the features of the instant claims except the following:

- a. Detecting whether the character is turning in a predetermined direction and to display the character with the upper body in the direction of the turn. (*Claim 78*)

- b. Detecting whether the character is being subjected to a wind and controlling the character to be moved in the direction of the wind. (*Claim 80*)

Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan in view of *Shimajima*.

Shimajima discloses an analogous video game system wherein software executed by a game device allows a player to control a game character to ski down a mountain based on the operational amount of user input device. In accordance with the skiing theme, the system detects whether the character is turning in a predetermined direction and to display the character with the upper body in the direction of the turn. *See fig. 16(a)(b), 18. (Claim 78)* Additionally, the system *detects* whether the character is being subjected to a wind and controls the character to be moved in the direction of the wind. *See col. 10:8-19. (Claim 80)* As a result, the system provides a more realistic impression of a human's physical movements and interaction with environmental conditions. *See col. 1:15-45, 8:53-54.*

In view of *Shimajima*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the video game system suggested by the combination of *Miyamoto '959* with *Sonic* to add the feature of detecting whether the character is turning in a predetermined direction and to display the character with the upper body in the direction of the turn and detecting whether the character is being subjected to a wind and controlling the character to be moved in the direction of the wind. The modification would increase the attraction of players by providing a more realistic impression of a human's physical movements and interaction with environmental conditions to enhance the player's interaction with the game thereby increase the developer's revenues by attracting a greater number of consumers.

CLAIM REJECTIONS - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 69-77, 79 and 81-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Sonic* in view of Reeves, U.S. Patent 5,436,640 (Jul. 25, 1995) (hereinafter "*Reeves*").

Sonic describes following features of the instant claims:

- a. Displaying a player-controlled character and responding to changes in joystick to control the direction of motion of the player-controlled character. (*Claim 69*)
- b. Displaying a character running motion if the amount of joystick input is above a predetermined value. (*Claim 70*) In particular, *Sonic* provides different animation s to depicts the game character moving at various speeds based on the operational amount of the user input.
- c. Displaying a character in a running motion which is at a higher rate than when the amount of joystick input is a first predetermined value, if the amount of joystick input is at a second predetermined value greater than the first predetermined value. (*Claim 71*)
- d. Displaying the character in a walking motion if the amount of joystick input is below a predetermined value. (*Claim 72*)
- e. Displaying the character in one of an acceleration running mode and a deceleration running mode. (*Claim 73*). In particular, *Sonic* displays acceleration by animating the character at increasing speeds and displays deceleration by animating the character to come to an abrupt stop.

Art Unit: 3714

- f. Applying a different relationship between the amount of joystick change and the speed of motion in the acceleration and deceleration modes. (*Claim 74*) In particular, *Sonic* displays acceleration by animating the character at increasing speeds and displays deceleration by animating the character to come to an abrupt stop.
- g. Detecting whether a character is moving on a sloped surface and to modify the character's moving speed as a function of the slope of the surface. (*Claim 75*)
- h. Detecting whether the character is moving on an upwardly inclined sloped surface relative to the character's direction of movement. (*Claim 76*)
- d. Displaying the character in a running motion with the upper body tilted forward if the amount of the input is above a first predetermined value. (*Claim 77*)
- i. Detecting whether a character is being subjected to an environmental condition and to control the character's movement as a function of the detected condition. (*Claim 79*). In particular, *Sonic* displays the game character standing on a platform moved vertically by a water spout. Also, it displays the game character sliding down a inclined slope covered in water.
- j. Environmental condition is the condition of the terrain on which the character is disposed and the character's movement is controlled as function of the terrain condition. (*Claim 81*) In particular, *Sonic* displays the game character standing on a platform moved vertically by a water spout. Also, it displays the game character sliding down a inclined slope covered in water.
- e. Detecting whether the character has been motionless for a predetermined period of time to control the motion of the character to be indicative of inactivity. (*Claim 82*) In particular, if the player does not input a command for a predetermined period such that the game character remains motionless, the game character will be display behaviors indicating boredom such as yawning, tapping his foot and checking his watch

However, *Sonic* does not describe the following features:

Art Unit: 3714

- a. Controlling the direction of motion of the player-controlled character responding to the amount of change in the joystick angular rotation to control the rate of the characters motion.

(Claim 69)

- b. Displaying the character in a sleeping state. (Claim 83)

Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan.

In regards to claim 69, *Reeves* discloses a video game and simulator joystick wherein the motion of the user-controlled object responds to the amount of change in the joystick angular rotation to control the rate of the characters motion. In view of *Reeves*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Sonic*, wherein proportional control of a game character is input according the operational amount of user input, to add the feature of controlling the direction of motion of the player-controlled character responding to the amount of change in the joystick angular rotation to control the rate of the characters motion to enhance players' control of a game character.

In regards to claim 83, if the player does not input a command for a predetermined period such that the game character remains motionless, the game character will be display behaviors indicating boredom such as yawning, tapping his foot and checking his watch. Sleeping is in equivalent means of indicating inactivity. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Sonic*, to add the feature of displaying the character in a sleeping state if the player does not input a command for a predetermined period to indicate inactivity.

Claims 78 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Sonic* in view of *Reeves*, as applied to claims 77, 82 and 83 above, in further view *Shimajima*

The video game system suggested by the combination of *Sonic* with *Reeves* describes all the features of the instant claims except the following:

Art Unit: 3714

- a. Detecting whether the character is turning in a predetermined direction and to display the character with the upper body in the direction of the turn. (*Claim 78*)
- b. Detecting whether the character is being subjected to a wind and controlling the character to be moved in the direction of the wind. (*Claim 80*)

Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan in view of *Shimojima*.

Shimojima discloses an analogous video game system wherein software executed by a game device allows a player to control a game character to ski down a mountain based on the operational amount of user input device. In accordance with the skiing theme, the system detects whether the character is turning in a predetermined direction and to display the character with the upper body in the direction of the turn. *See fig. 16(a)(b), 18. (Claim 78)* Additionally, the system *detects* whether the character is being subjected to a wind and controls the character to be moved in the direction of the wind. *See col. 10:8-19. (Claim 80)* As a result, the system provides a more realistic impression of a human's physical movements and interaction with environmental conditions. *See col. 1:15-45, 8:53-54.*

In view of *Shimojima*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify video game system suggested by the combination of *Sonic* with *Reeves* to add the feature of detecting whether the character is turning in a predetermined direction and to display the character with the upper body in the direction of the turn and detecting whether the character is being subjected to a wind and controlling the character to be moved in the direction of the wind. The modification would increase the attraction of players by providing a more realistic impression of a human's physical movements and interaction with environmental conditions to enhance the player's interaction with the game thereby increase the developer's revenues by attracting a greater number of consumers.

Conclusion

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure:

- *Sonic the Hedgehog Instruction Manual*, Sega, Inc. (1991) generally describes the game and the joystick controls. *See p. 3.*
- *Sonic the Hedgehog*, retrieved from the Internet <URL: www.emulationzone.org/fanfare/ghz/-sonic/son1/son1.html> describes the controls of *Sonic* including changes in speed. *See pp. 1-2.* Also, it depicts the game character laying-down yawing. *See id.* Additionally, it depicts the game character's movement controlled as a result of a terrain condition. *See p. 4* (depicts the character standing on a platform being moved vertically on a water spout). Furthermore, it illustrates the game character's upper body positioned vertically while walking and leaning forward when running. *See p. 10.* Moreover, it describes *Sonic* detecting whether a character is moving on a sloped surface and to modify the character's moving speed as a function of the slope of the surface. *See p. 2.*
- *Sonic the Hedgehog*, <URL: www.planetdreamcast.com/sonic/sonic/songames/gen_sonic/-general.html> illustrates the character's movement controlled as function of a terrain condition. *See p. 2* (Zone #4 depicts the game character sliding down a inclined slope covered with water).
- *Sonic the Hedgehog*, <URL: www.geocities.com/triacesuperfan/sonicreview.html> describes the game character tapping his foot when left idle. *See p. 2.* Also, it describes the different animations for the game character including breathing, running at different speeds, jumping, standing idle, sliding down a waterfall, coming to an abrupt stop, etc. *See p. 2.*
- *Sonic the Hedgehog 3*, <URL: www.gamefaqs.com/console/genesis/review/R18046.html> describes *Sonic the Hedgehog 3*, a successive version if *Sonic*, released in 1994 wherein the game character yawns when left idle.

Art Unit: 3714

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9302 for regular communications and 703 872 9303 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.



Steven Ashburn
September 22, 2002



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